

1 The opinion in support of the decision being entered today
2 was *not* written for publication and
3 is *not* binding precedent of the Board.
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7 UNITED STATES PATENT AND TRADEMARK OFFICE
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10 BEFORE THE BOARD OF PATENT APPEALS
11 AND INTERFERENCES
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14 *Ex parte* TRACY L. FRANCIS, MARK W. JONES and
15 RICHARD F. ROBINSON
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18 Appeal No. 2007-0793
19 Application No. 09/875,487
20 Technology Center 3600
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23 Decided: March 22, 2007
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26 Before TERRY J. OWENS, ROBERT E. NAPPI, and LINDA E. HORNER,
27 *Administrative Patent Judges*.
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29 NAPPI, *Administrative Patent Judge*.
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32 DECISION ON APPEAL
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34 This is a decision on appeal under 35 U.S.C. § 134 of the final
35 rejection of claims 15 through 33. For the reasons stated *infra* we will not
36 sustain the Examiner's rejection of these claims.

INVENTION

The invention is directed to a method for design professionals to provide comments to manufacturers of floor coverings, regarding the commercial potential of products. The method makes use of an Internet-based system where the design professional can provide written and ballot style comments (a survey) and also can order physical samples. See pages 3 and 4 of Appellants' specification. Claim 15 is representative of the invention and reproduced below:

15. An interactive computer based system for review of product designs, patterns and/or colors comprising a computer controlled internet-based interactive communications site for electronically communicating to a multiplicity of pre-qualified subscribers one or more product designs in conjunction with a ballot style rating scale including a plurality of selectable response menu items indicating varying levels of likelihood of use of said one or more product designs wherein only a single menu item may be selected for each design such that a single rating selection may be made by each of said subscribers and transmitted back to the Web site for each of said one or more product designs whereby the likelihood of use of said one or more product designs may be estimated, the system further comprising means for said subscribers to enter individualized comments concerning said one or more product designs and an interactive electronic shopping cart accessible by said subscribers for ordering physical samples and/or products incorporating said one or more product designs wherein the interactive shopping cart is accessible by a link from a web document displaying both a product design and said selectable response menu items as initially communicated to subscribers, such that the shopping cart is accessible directly from said web document independent of selecting any given response menu item.

REFERENCES

The references relied upon by the Examiner are:

Thomas	US 2002/0002482 A1	Jan. 03, 2002 (filed Jul. 01, 1997)
Sandus	US 2002/0072993 A1	Jun. 13, 2002 (effectively filed Nov. 3, 2000)

REJECTION AT ISSUE

Claims 15 through 33 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Thomas in view of Sandus. The Examiner's rejection is set forth on pages 2 through 4 of the Final Office action mailed May 31, 2005. Throughout the opinion we make reference to the Brief (filed December 29, 2005), and the Answer (mailed March 7, 2006) for the respective details thereof.

ISSUES

Appellants contend that the Examiner's rejection of independent claims 15, 22 and 27 under 35 U.S.C. § 103 (a) is in error. Appellants assert, on page 4 of the Brief, that Thomas is directed to a survey system and Sandus is directed to an on line sales and marketing system. Appellants argue, on pages 4 and 5 of the Brief, that one skilled in the art would not be motivated to combine the references as asserted by the Examiner to include an online survey and a shopping cart to order samples or products.

The Examiner contends that the rejection is proper and states on page 6 of the Answer:

[T]he secondary reference Sandus identifies in the background of the invention (Pg. 1 para. 6) that ecommerce transactions in

1 and of themselves are a method of gathering consumer data that
2 is later used for two purposes; 1. boost revenues and lower
3 costs 2. improving customer service by providing products they
4 need or prefer. Both Thomas and Sandus are directed to
5 gathering data about consumer (market research) in order to
6 provide consumers with products they will buy, therefore
7 Thomas and Sandus do fall into an analogous art description.
8 The examiner further notes that Sandus teaches providing a
9 business model that allows for enhanced customer services
10 features while using [sic] less intrusive data marketing
11 techniques while keeping customers abreast of products and
12 services. (Pg 3 Para. 27). This suggests to one of ordinary skill
13 in the art a method for manufactures [sic] to gain market
14 information while still allowing merchants to provide access to
15 new products and information
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17 Thus, the contentions present us with the issue of whether or not one
18 skilled in the art when viewing the disclosures of Thomas and Sandus
19 would be motivated to combine the survey with the electronic shopping cart
20 to order physical products or samples.

21 FINDINGS OF FACT

22 Thomas teaches a system where users are registered to take part in
23 surveys. See abstract and paragraph 0029. Thomas states that one
24 advantage of the surveys being given over the internet is that multimedia
25 displays may be incorporated in to the survey. See paragraph 0010 and
26 0028. Thomas discusses the surveys being used to gain information on
27 many topics including gaining marketing information. See paragraph 0005.
28 However we find no discussion of provisions for the users to order samples
29 or products of items related to the survey.

30 Sandus teaches a system for online retail. Users are presented with a

1 virtual shopping mall. The environment of the virtual shopping mall may
2 take on many different characteristics based upon user preferences. See
3 generally paragraphs 0079 through 0082. Sandus also discusses that the
4 shopping habits of the users may be monitored to gain marketing
5 information. See paragraphs 0006 and 0151. Sandus states that the virtual
6 shopping mall may include the functionality of a shopping cart. See
7 paragraph 0083. Sandus discloses no mechanism where users are presented
8 with a survey, i.e., ballot style rating scales and means to enter comments.

9 PRINCIPLES OF LAW

10 As was recently described in *In re Kahn*, 441 F.3d 977, 78 USPQ2d
11 1329 (Fed. Cir. 2006):

12 [T]he “motivation-suggestion-teaching” test asks not merely what the
13 references disclose, but whether a person of ordinary skill in the art,
14 possessed with the understandings and knowledge reflected in the
15 prior art, and motivated by the general problem facing the inventor,
16 would have been led to make the combination recited in the claims.
17 From this it may be determined whether the overall disclosures,
18 teachings, and suggestions of the prior art, and the level of skill in the
19 art – i.e., the understandings and knowledge of persons having
20 ordinary skill in the art at the time of the invention-support the legal
21 conclusion of obviousness. (internal citations omitted).

22 *Id.* at 988, 78 USPQ2d at 1337. To establish a prima facie case of
23 obviousness, the references being combined do not need to explicitly
24 suggest combining their teachings. *See id.* at 987-88, 78 USPQ2d at 1337-
25 38 (“the teaching, motivation, or suggestion may be implicit from the prior
26 art as a whole, rather than expressly stated in the references”). “The test for
27 an implicit showing is what the combined teachings, knowledge of one of
28 ordinary skill in the art, and the nature of the problem to be solved as a

1 whole would have suggested to those of ordinary skill in the art.” *Id.* at
2 987-88, 78 USPQ2d at 1336 (quoting *In re Kotzab*, 217 F.3d 1365, 1370, 55
3 USPQ2d 1313, 1317 (Fed. Cir. 2000)).

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ANALYSIS

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7 We do not find sufficient facts in either Thomas or Sandus to support
8 the conclusion that one skilled in the art would have been motivated to
9 include the survey of Thomas in the shopping environment of Sandus, as
10 required by independent claims 15, 22, and 27. Thomas’s stated purpose is
11 to more effectively carry out surveys. See paragraph 0009. Thomas
12 contemplates the system being used on all types of surveys. See paragraph
13 0005. We do not find evidence or suggestion which would motivate one
14 skilled in the art to couple the survey system with a sales system such as
15 Sandus.

16

17 Sandus is concerned with creating an online shopping environment
18 which supports multiple vendors and is aesthetically pleasing to the
19 customers. See paragraphs 0025 and 0026. While Sandus does discuss
20 obtaining data from the user’s shopping transactions, we do not find that
21 this suggests that users should be subjected to a survey such as taught by
22 Thomas.

23

24 Thus, we do not find that the skilled artisan reviewing Thomas and
Sandus would have been motivated to combine the teachings to arrive at the
claimed invention as asserted by the Examiner. Accordingly we will not
sustain the Examiner’s rejection under 35 U.S.C. § 103 (a).

CONCLUSION

We consider the Examiner's rejection under 35 U.S.C. § 103 (a) to be in error as we do not find that the combination of the references applied by the Examiner teach all of the limitations of independent claims 15, 22, or 27. Accordingly we will not sustain the Examiner's rejection of independent claims 15, 22, or 27, or dependent claims 16 through 21, 23 through 26, and 28 through 33 under 35 U.S.C. § 103 (a).

ORDER

For the forgoing reasons, we will not sustain the Examiner's rejection of claims 15 through 33 under 35 U.S.C. § 103. The decision of the Examiner is reversed.

REVERSED

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